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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,834	02/08/2002	Wai Choi Tang	016660-115	9561

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EXAMINER
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CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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02/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/067,834

Applicant(s)

TANG, WAI CHOI

Examiner

Joshua D. Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-13, 15, and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/30/2007.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment and IDS filed 11/30/2007.
2. Claims 1-5, 9-13, and 15-19 are pending in this case. Claims 17-19 have been withdrawn from consideration. Claims 1 and 13 are independent claims. Claim 16 has been newly added. Claims 6-8 and 14 have been cancelled. Claims 1, 5, 9, 10, 13, and 15 have been amended.
3. The rejection of claim 13 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter has been withdrawn due to amendments.

### ***Election/Restrictions***

4. Newly submitted claims 17-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, 9-13, 15, and 16, drawn to displaying a selection including hierarchically preceding data in a separate window, classified in class 715, subclass 277.
  - II. Claims 17-19, drawn to linking memo fields to words in a list, classified in class 715, subclass 230.

The inventions are distinct, each from the other because of the following reasons:

6. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as displaying selections including preceding hierarchical data in a separate window. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

7. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

8. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

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because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

9. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1-5, 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Chasen et al. (hereinafter Chasen, US Patent Number 6,760,721, filed on April 14, 2000).

**Regarding independent claim 1,** Chasen discloses providing within a display window in an interface a visual display of a plurality of words arranged hierarchically into a plurality of levels based on a database of those words (column 1, lines 39-50 and column 5, line 52-column 6, line 4 of Chasen). Chasen also discloses that a user may choose a word or words from a plurality of words shown in said window and then outputting an output in response to the choice of a word or words (column 5, line 52-column 6, line 4 of Chasen). Chasen discloses that words that are chosen are then displayed in a second window on the visual display unit and in the second window the words chosen are displayed with at least a word of the immediately preceding level (when classical is selected the word classical is shown in the second window in conjunction with the word that immediately precedes it, genre, as is shown in Figure 1) (column 5, line 52-column 6, line 4 of Chasen). The table column “:Genre” containing the selection of “Classical” being a descriptor in the teachings of Chasen (Figure 1 and column 5, line 52-column 6, line 4 of Chasen). Chasen also discloses that the items can be described by a specific descriptor of their hierarchical location, which consists of

preceding hierarchical level and the chosen word separated by a "-" (column 13, line 45-column 15, line 64 of Chasen).

**Regarding dependent claims 2 and 3**, Chasen discloses that the user's computing device can be a personal computer or a personal digital assistant (column 6, lines 52-62 of Chasen).

**Regarding dependent claim 4**, Chasen discloses that the database of words provided exists and is provided from the memory of the user's processing apparatus (column 6, lines 22-29 and lines 49-52 of Chasen).

**Regarding dependent claims 5**, Chasen discloses that the output in response to the selection may be visual (showing items that fall under the classification of the word selected) and audible (playing the audio filed designated by the word selected) (column 5, line 52-column 6, line 4 and column 8, lines 7-13 of Chasen).

**Regarding dependent claims 9 and 10**, Chasen discloses displaying a plurality of chosen words in the second window in a relational manner by allowing multiple words such as "Concerto" and "Reverie" to be added to a playlist window that exists in the same format as the window 130 in Figure 1, thus maintaining a relational display of the words selected based on the categories of classification provided (column 5, line 20-column 6, line 4 of Chasen).

**Regarding dependent claims 11 and 12**, Chasen discloses that words may be added to the database and any changes made to a word will be propagated throughout the database to all occurrences of a word in a database, thus allowing all occurrences to be changed (column 3, lines 43-58 of Chasen).

**Regarding independent claims 13**, Chasen discloses a program which when processed by a data apparatus provides within a display window in an interface a visual display of a plurality of words arranged hierarchically into a plurality of levels based on a database of those words (column 1, lines 39-50 and column 5, line 52-column 6, line 4 of Chasen). Chasen also discloses that a user may choose a word or words from a plurality of words shown in said window and then outputting an output in response to the choice of a word or words (column 5, line 52-column 6, line 4 of Chasen). Chasen discloses that words that are chosen are then displayed in a second window on the visual display unit and in the second window the words chosen are displayed with at least a word of the immediately preceding level (when classical is selected the word classical is shown in the second window in conjunction with the word that immediately precedes it, genre, as is shown in Figure 1) (column 5, line 52-column 6, line 4 of Chasen). The table column "Genre" containing the selection of "Classical" being a descriptor in the teachings of Chasen, which provides the description that "Classical" is hierarchically preceded by the word "Genre" (Figure 1 and column 5, line 52-column 6, line 4 of Chasen). Chasen also discloses that the items can be described by a specific descriptor of their hierarchical location, which consists of preceding hierarchical level and the chosen word separated by a "-" (column 13, line 45-column 15, line 64 of Chasen).



***Claim Rejections - 35 USC § 103***

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chasen et al. (hereinafter Chasen, US Patent Number 6,760,721, filed on April 14, 2000).

**Regarding dependent claim 15**, Chasen discloses the use of executable programmed instructions in order to perform the tasks of the invention of Chase. Chasen does not explicitly disclose the executable programs are stored on an optically readable data disc. However, it was notoriously well-known to use an optically readable data disc (such as a CD) to provide executable programs to a processing device at the time the invention was made. It would have been obvious to one of ordinary skill in the art, at the time the invention was made to have provided the program taught by Chasen on an optically readable data disc because it would have increased the portability of the program because it would have allowed it to be easily transported computer to computer via the data disc.

15. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chasen et al. (hereinafter Chasen, US Patent Number 6,760,721, filed on April 14, 2000) in view of Pfaffenberger et al. (hereinafter Pfaffenberger, "Microsoft Windows 98 and the Internet," published in 1999).

**Regarding dependent claim 16**, Chasen discloses that the items can be described by a specific descriptor of their hierarchical location, which consists of

preceding hierarchical level and the chosen word separated by a "-" (column 13, line 45- column 15, line 64 of Chasen). Chasen does not explicitly disclose the use of the "\" symbol to describe the relationship of the item and the preceding hierarchical level by separating them with said "\" symbol. However, it is notoriously well known in the art at the time the invention was made that the "\" symbol was most commonly used to dictate the hierarchical levels between words by separating them in the format of preceding hierarchical item followed by a "\" symbol followed by the actual item (page 617, Figure 16-7 of Pfaffenberger, specifically the "Address" bar in relation to the selection made in the "All Folders" window). Thus, it would have been notoriously obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Chasen for using a "-" to separate hierarchically preceding elements with the notoriously well-known teachings of Pfaffenberger because the "\" symbol would have provided a commonly used representation of hierarchical elements, thus it would have been more commonly understood by more users.

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1-5, 9-13, 15 and 16 have been considered but are moot in view of the new ground(s) of rejection.

17. Regarding the submission of the IDS, the newly submitted IDS containing full copies of all of the foreign patent documents is now proper and has been considered. However, based on the comments found in the response in the paragraph bridging pages 9 and 10, the examiner feels it is necessary to point out that the USPTO not only

suggests that a complete copy of each foreign patent document be provided, it is also required as can be clearly found in the MPEP (37 CFR 1.98(a)(2)). For future IDS submissions the examiner recommends consulting the MPEP (specifically 37 CFR 1.97 and 1.98) to avoid any future misunderstandings.

### ***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

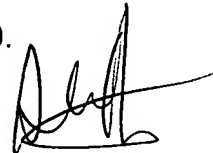
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JDC  
February 8, 2008

STEPHEN HONG  
SUPERVISORY PATENT EXAMINER